

Appn. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

RECEIVED
CENTRAL FAX CENTER
MAY 29 2007

REMARKS

Reconsideration is respectfully requested.

Claims 2 through 9, 29 through 34 and 36 through 40 remain in this application. Claims 1, 10 through 23 and 28 have been cancelled. Claims 24 through 27 have been withdrawn. No claims have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 2 and 3 of the Office Action

Claims 1, 3 through 9 and 29 through 39 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

Withdrawal of the §112 rejection of claims 3 through 9 and 29 through 39 is therefore respectfully requested.

Paragraph 5 of the Office Action

Claims 2 through 9 and 29 through 39 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bezos.

Initially, it is noted that the rejection states that:

Applicant's attempt at traversing the Official Notice findings as stated in the June 8, 2004 Office Action is inadequate. Adequate traversal is a two step process. First, Applicant must state their traversal on the record. Second, and in accordance with 37 C.F.R. § 1.111(b) which requires Applicant to specifically point out the supposed errors in the Office Action, Applicant must state why the Office Action statements are not to be considered common knowledge or well known in the art.

Appln. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

In this application, Applicant has not met step (1) as no traversal of Official Notice has been taken. Merely disagreeing with the analysis does not rise to the level of traversal. Second, Applicant has failed step (2) since they have failed to argue why the Official Notice statements are not to be considered common knowledge or well known in the art. The standard of functionality is not convincing. Being not well known is not determinative, but whether it is known, even if in limited public circles. Because Applicant's traversal is inadequate, the Official Notice, e.g. common knowledge, statements are taken to be admitted as prior art. See, MPEP §2144.03.

The rejection thus appears to reject the challenge of the taking of "Official Notice" as being inadequate. However, it appears that the analysis set forth in the rejection of the Office Action sets forth requirements that go significantly beyond the requirements set forth in the rules and regulations set forth in the Manual of Patent Examining Procedure (MPEP) as discussed further below.

Initially, it is noted that the discussion in the previous response of the taking of "Official Notice" by the Patent Office stated that "[a]pplicant challenges" the Patent Office to "provide evidence that these elements [contained in the quoted language of the rejection] of the claimed invention are "common knowledge" as asserted in the rejection" emphasis and bracketed material added). It appears that the Office has taken the position that this statement of the previous response, along with the other statements in the response regarding the "Official Notice", is "inadequate" to put the Patent Office on notice of the challenge, but the language of the previous response clearly states that the Official Notice is challenged and directly quotes the language of the Official Notice.

It is noted that the relevant subsection (c) of MPEP 2144.03 states:

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would

Appln. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("In the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

It is believed to be significant that --§2144.03(c) of the MPEP--the section applicable to challenges to Official Notice--adopts language from the *Chevenard* opinion that states "[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention" (emphasis added). Thus it is the "absence of any demand" that is the concern of the courts when challenging Official Notice. It is submitted that the statements made in the previous response do not amount to "the absence of any demand by applicant", as stated by the portion of the *Chevenard* incorporated into the MPEP, and thus it cannot be said that the challenge is "inadequate", at least under the literal statements set forth in the MPEP.

Further, it is noted that the example of an "inadequate" challenge (also underlined in the text above quoting MPEP §2144.03(c)) refers to the inadequacy of a "general allegation that the claims define a patentable invention". Clearly, an "adequate" challenge of Official Notice is just more than a general allegation of patentability, and is more than the absence of any demand. Either of these standards are submitted to be met by the language of the previous response, which is clearly more than just a

Appn. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

"general allegation that the claims define a patentable invention", as the challenge identified (by quoting the language of the Office Action) the elements that were being asserted as "common knowledge" in the rejection. The language of the previous response regarding the challenge of the Official Notice 1a is reproduced here in full:

Clearly the Patent Office recognizes this significant gap in the disclosure of Bezos, as the rejection further states:

Official Notice is taken that Applicant's data entry device, notification system and accumulator have been common knowledge in the art prior to Applicant's filing date. To have provided Bezos a data entry device and accumulator for approval by an originating user would have been obvious to one of ordinary skill in the art in view of Official Notice.

Applicant challenges the Patent to provide evidence that these elements of the claimed invention are "common knowledge" as asserted in the rejection, and also, even if these elements are assumed to be common knowledge for the purpose of argument only, how they would lead one of ordinary skill in the art to the claim requirement of "an accumulator module... configured to provide any accumulated orders to the originating user for approval by the originating user to be submitted via the network connection". It appears that this argument is based upon an assumption that if the elements are known, a (seemingly unrelated) function becomes obvious.

Further, it is submitted that above language of the previous response set forth the "supposed errors" in the "Official Notice" by specifically stating that the language of the allegedly "common knowledge" elements stated in the "Official Notice" were not commensurate with the actual requirements of the claims. For example, the rejection merely and summarily stated that "[a]pplicant's data entry device, notification system, and accumulator have been common knowledge", as if this were the complete requirements of the claims. In contrast, the language of claim 35 required "a notification module configured to provide a notification to other selected users when the order is created by the originating user" and "an accumulator module configured to accumulate any orders from the other

Appn. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

selected users in response to the notification and configured to provide any accumulated orders to the originating user for approval by the originating user to be submitted via the network connection" (all emphasis added).

The language of the rejection in the final Office Action appears to attempt to brush aside the functional requirements of these claim elements, but it is noted that this language is not merely "intended use claim language", as alleged in the rejection, but functional requirements that limit the elements set forth in the claim. See, for example, the MPEP at §2173.05(g), which states in part (emphasis added):

Functional Limitations [R-3]

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. >In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." "In the absence of modifiers, general descriptive terms are typically construed as having their full meaning." *Id.* at 1118, 72 USPQ2d at 1006. In the patent claim at issue, "subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008.<

Appn. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

It is therefore submitted that the functional language of the claims must be considered, as the functional language sets forth real requirements and limitations on the "notification" and "accumulator" elements of the claims. It is further asserted that these particular functions are not only not known in the "common knowledge" of those skilled in the art, but are not apparent in view of the disclosure of Bezos, as discussed in further detail below.

As previously noted, claim 35 requires, in part, "an accumulator module configured to accumulate any orders from the other selected users in response to the notification and *configured to provide any accumulated orders to the originating user for approval by the originating user to be submitted via the network connection*" (emphasis added).

It is asserted in the rejection of the Office Action that:

Bezos discloses an electronic retail system comprising a notification module, e.g. 36-38, and an accumulator, e.g. Fig. 4, 152. Bezos does not explicitly disclose a data entry device. However, Bezos does disclose, e.g. col. 4, lines 57-67, a mechanism for making a purchase order.

While it is alleged in the rejection that the Bezos patent discloses the claimed accumulator, it is submitted that the Bezos patent does not disclose "an accumulator module configured to accumulate any orders from the other selected users *in response to the notification*" and does not disclose "an accumulator module... configured to provide any accumulated orders *to the originating user for approval by the originating user to be submitted via the network connection*". More specifically, the system of the Bezos patent is directed to providing information to other persons in the community about purchases that *have been completed*. See, for example, col. 7, lines 36 through 44 of Bezos, which states (emphasis added):

The sign-up page also includes check boxes 36 38 for allowing users to participate in the Contact Information Exchange, Hotseller Notification, and Purchase Notification services, respectively. In each case, the user may select a corresponding link 40 42 to an associated form page (not shown) to limit participation to specific communities

Appn. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

and/or product categories. Each user may also be given the option to expose his or her purchases and/or contact information to others on a user-by-user basis.

Not only does this portion suggest to one of ordinary skill in the art that the user's purchases have already been completed, there is no indication whatsoever that the user has any ability to approve of any other purchases, even if this option is selected. It is submitted that the Bezos patent, if anything, could only lead one of ordinary skill in the art away from the claimed invention and the requirement of "an accumulator module... configured to provide any accumulated orders to the originating user for approval by the originating user to be submitted via the network connection" as required by claim 35. Neither the rejection of the Office Action, nor an inspection of the disclosure of the Bezos patent, reveals anything in Bezos that would lead one of ordinary skill in the art to this requirement.

Further, claim 35 also requires "a notification module configured to provide a notification to other selected users *when the order is created by the originating user*". As evidenced by the above, the Bezos system does not provide any indication to others in the community that a purchase has been made by another in the community until after the purchase has been completed.

Again, the rejection of the Office Action clearly recognizes this significant gap in the disclosure of Bezos, as the rejection further states:

Official Notice is taken that Applicant's data entry device, notification system and accumulator have been common knowledge in the art prior to Applicant's filing date. To have provided Bezos a data entry device and accumulator for approval by an originating user would have been obvious to one of ordinary skill in the art in view of Official Notice.

Applicant again challenges the Patent Office to provide evidence that the elements *as recited in the claims* are "common knowledge" as asserted in the rejection. Even if the elements *stated in the rejection* are assumed to be

Appn. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

common knowledge for the purpose of argument only, it is submitted that the "Official Notice" does not address the actual and full requirements of the language of the claims, particularly the functional requirements of the claim language. Further, it is not stated how the alleged knowledge of the "accumulator" could lead one of ordinary skill in the art to the claim requirement of "an accumulator module... configured to provide any accumulated orders *to the originating user for approval by the originating user* to be submitted via the network connection". Again, it is submitted that simply because one may believe that an element is known, a (seemingly unrelated) function does not necessarily become obvious by knowledge of the element.

It is therefore submitted that the Bezos patent set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1 and 35. Further, claims 2 through 7 and 29 through 34, which depend from claim 1, claim 8, which depends from claim 7, claim 9, which depends from claim 8, and claims 36 through 39, which depend from claim 35 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Claim 40 requires that "the notification sent by the notification module to the other selected users is performed before the order is submitted for fulfillment". It is noted that the Bezos patent discusses a system in which the notification of other persons in the community occurs (as noted above) *after* the order has been submitted, as evidenced in the Bezos patent at col. 2, line 63 through col. 3, line 16 (emphasis added):

In accordance with another aspect of the invention, a service is provided for notifying users interested in particular products of other users that have purchased the same or similar products. In one embodiment, the service is implemented by providing user contact information on product detail pages. For example, when a user views a product detail page for a particular product (such as a kayak), the detail page may be customized to include the names and email

RECEIVED
CENTRAL FAX CENTER

Appln. No. 09/943,883
Amendment dated May 29, 2007
Reply to Office Action mailed

MAY 29 2007

addresses of other members of the user's community (such as a kayaking club) that recently purchased the same product. If any of these other members is online, the user may be presented the option to send an instant message or otherwise chat online with such members. In one implementation, users can opt to expose their contact information to other community members (and thus participate in the service) on a community-by-community basis. A variation of this service involves notifying users interested in particular merchants (e.g., sellers on an online auction site) of the contact information of other users (preferably fellow community members) that have engaged in business with such merchants.

In view of the above portion of the Bezos patent, it is submitted that one of ordinary skill in the art would clearly understand that any notification occurs *after* a purchase has been made, and thus after the order has been submitted.

Withdrawal of the §103(a) rejection of claims 2 through 9 and 29 through 39 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited..

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. 40,158
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357

Date:

May 29, 2007